

REMARKS

Summary of the Response

Claims 2, 48-51 and 86-89 have been amended. Claims 1-94 remain pending in this application.

Summary of the Rejections

The Examiner noted that the Information Disclosure Statement filed 10/2/98 is deficient with respect to citation of Canadian patent 2036131. The Examiner rejected claims 1-3, 7, 8, 12, 17, 20-26, 29-32, 37-40, 42-47, 56, 57, 61-64, 74-78 and 80-85 based on non-statutory double patenting with respect to Applicant's U.S. Patent No. 5,802,280. The Examiner provisionally rejected claims 1, 2, 8, 9, 11, 13-17, 20-26, 31, 33-34, 37-39, 41-56, 61-65, 68-71 and 73-94 based on non-statutory double patenting with respect to Applicant's co-pending Application No. 08/871,221. The Examiner rejected claims 1, 3-10, 12, 16, 18-32, 35-40, 44, 46-69, 74-78, 80 and 82-84 based on non-statutory double patenting with respect to Applicant's U.S. Patent No. 5,764,892. The Examiner rejected claims 2, 9, 11, 12, 48-52 and 86-90 as being indefinite under 35 U.S.C. § 112, second paragraph. The claims 1-8, 12, 14, 17-49, 53-83 and 91-94 were rejected under 35 U.S.C. § 103(a) as being obvious over U.S. Patent No. 5,218,367 to Sheffer. Claims 9-11, 13, 15 and 16 were rejected under 35 U.S.C. § 103(a) as being obvious over Sheffer and U.S. Patent No. 5,778,367 to Wesinger. (On page 16, just above the § 102 rejection, the examiner appeared to have rejected claim 31-37, 39-41, 56-83 and 91-94 on the same basis as

claim 1-30, 38, 42-55 and 84-90. However, it is unclear what that basis might be.) The examiner rejected claims 1-8, 10, 17-40, 42-67, 71-76 and 81-94 under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 5,802,280 to Cotichini, and rejected claims 9, 11-16, 41, 68-70 and 77-80 under 35 U.S.C. § 103(a) as being obvious over Cotichini in view of Wesinger. These rejections are respectfully traversed.

Summary of the Invention

The present invention is directed to a novel method and apparatus for tracing an electronic device, such as a computer. According to the present invention, an Agent within the electronic device is configured to transmit identifying indicia for the electronic device (device components thereof) to a host system automatically. In one aspect of the invention, a global network communication link (e.g., the Internet, cablevision network, telephone network, wireless radio network, microwave network, etc.) is provided to enable transmission between the electronic device and the host system. In another aspect of the present invention, the global network communication link is used for determining the location of the electronic device (e.g., by means of a traceroute routine and/or the location information within the identifying indicia).

The present application is a continuation-in-part of several parent and grandparent applications, which share certain overlapping disclosures but claim different inventive aspects. For example, parent U.S. Patent No. 5,802,280 (which was commonly assigned to the assignee of the present application) claims providing an identifying indicia of the electronic device, but does not more specifically claim determination of the location of the device based on tracing of the communication link as claimed in the present application.

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Traversal of Rejections

1. Non-Statutory Double Patenting Rejection

Applicant does not understand the Examiner's basis for the non-statutory double patenting rejections with respect to U.S. Patent No. 5,802,280, U.S. Patent No. 5,764,892 and copending patent application serial no. 08/871,221. Applicant respectfully submits that the examiner's non-statutory double patenting rejections are moot in this case, in view that the inherent term of any patent issuing from the present application would expire on or before the expiration of the cited patents and patent application. Applicant notes that the present application claims the priority of the grandparent application 08/339,978, from which '280 and '892 patents are continuation-in-parts, and the '221 application claims the priority of the '892 patent and '280 patent. Applicant further notes that the present application, the '280 patent, the '892 patent and the '221 application were all filed after 6/7/95, therefore subject to a 20-year patent term measured from the priority date. Accordingly, any patent issuing from the present application would necessarily expire along with the '892 and '280 patents and '221 application, 20 years from the priority of the grandparent '978 application. The double patenting rejections are therefore traversed.

It follows that Applicant does not even need to submit a terminal disclaimer to overcome the non-statutory double patenting rejections, even if such rejections have merits. However, Applicant reserves the right to file a terminal disclaimer should it becomes necessary to do so to obtain allowance of the present application.

2. 35 U.S.C. §112 Rejections

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With respect to claim 2, Applicant amended claim 2 to provide proper antecedent basis.

The Examiner's primary basis for rejecting the claims 48-52 and 86-90 as being indefinite relies on the concern that the Agent can be operated independently of instructions from the electronic device and be activated prior to the operating system. Applicant does not understand how the term "operating system" as used in the rejected claims is given a meaning "repugnant" to the usual meaning of "operating system". Nevertheless, in the interest of not delaying issuance of the case, Applicant amended claims 48-51, and 86-89 to clarify that the Agent is activated prior to normal system operations of the electronic device. The amendment avoid any confusion with the usually meaning of "operating system" noted by the Examiner.

Applicant respectfully submits that all the rejections under 35 U.S.C. 112, second paragraph have been traversed in view of the foregoing remarks and the amendments noted above.

3. Prior Art Rejection based on Sheffer

The Examiner rejected claims 1-8, 12, 14, 17-49, 53-83 and 91-94 as being obvious over Sheffer, and claims 9-11, 13, 15 and 16 as being obvious over Sheffer and Wesinger. These rejections are respectfully traversed.

Claim 1 has been amended to recite "providing the host system with one or more of the global communications links used to enable transmission between the electronic device and the host system, said transmission via said communication links used for determining the location of said electronic device." This clearly distinguishes from Sheffer. Sheffer is directed to a vehicle anti-theft system. It includes sensors that detect unauthorized operation of the vehicle and intrusions. The sensors, upon detection of a triggering condition, causes a controller to obtain

the triangulation data of the vehicle with respect to neighboring cell sites by determining the relative cellular signal strength from neighboring cell sites, and initiates a transmission of such triangulation data to a monitoring computer that would be relied upon for determining the location of the vehicle. In contrast, the present invention determines the location of the electronic device by relying on the transmission characteristic via the communication links, not triangulated location data that must first be collected and then transmitted to the monitoring computer as in the case of Sheffer. The transmission of such triangulation data in and of itself does not provide information on the location of the vehicle. Such location information is provided by the transmitted data instead. For the present invention defined in claim 1, the transmission via the communication is used for determining the location of the electronic device. Further, the communication links for the present invention is global, not a regional cellular network as in the case of Sheffer. Given that vehicle tracking is intended to be initiated immediately upon unauthorized intrusion, it would not be reasonable to expect the triangulation location data to be collected beyond a local region on a global basis. These differences are not obvious variations.

Applicant respectfully submits that Sheffer does not disclose or suggest if and how its vehicle tracking system can and should be modified to obtain the present invention as defined by claim 1 and the claims dependent therefrom. Such modification can only be possible with impermissible hindsight given the disclosure of the present invention. Even though the examiner rejected the claims as being obvious, the examiner has not render any comment on how Sheffer renders obvious the limitations of claim 1. The examiner seems to merely draw correspondence between Sheffer and claim 1. Accordingly, in view of the discussions above, Applicant clearly

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distinguished claim 1 from Sheffer. Applicant respectfully requests the examiner to clearly set forth the basis for the obviousness rejections should the examiner persist with such rejections.

Claims 9-11, 13, 15 and 16 depend from claim 1, and are therefore patentable as well over Sheffer for the same reasons given above. Wesinger does not make up for the deficiencies of Sheffer. There is no disclosure or suggestion in Sheffer or Wesinger if and how the Wesinger traceroute can and should be applied to the tracking system in Sheffer. Sheffer relies on a cellular phone network for communication and tracking. Wesinger on the other hand is directed to traceroute of IP addresses on the Internet. Accordingly, Applicant respectfully submits that it would not have been obvious to combine the teachings of Sheffer and Wesinger in the manner suggested by the Examiner.

With respect to independent claims 37 and 57, Applicant respectfully notes that Sheffer does not disclose loading an agent with the electronic device as required in claim 37, and Sheffer does not disclose determining the location of the electronic device based on location information represented by the identifying indicia (as opposed to triangulated location information separate from the vehicle identification information as in Sheffer) as required in claim 57. Applicant further respectfully notes that the Examiner did not set forth the basis of the obviousness rejections of independent claims 37 and 57. On page 16, the Examiner inferentially referred to claims 37 and 57 as being rejected on the same basis as claims 1 etc. without fully developing the basis of such rejection. If the Examiner intends to reject these claims, the Examiner must specify the basis for such rejection in an office action.

In view of the foregoing, applicant submits that the prior art rejections based on Sheffer either alone or in combination with Wesinger have been overcome.

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4. Prior Art Rejection Based on Cotichini

Applicant respectfully submits that U.S. Patent No. 5,802,280 to Cotichini has been commonly assigned to Absolute Software Corporation, the assignee of record for the present application. The present application claimed the priority of Cotichini. As such, Cotichini is not a proper reference that can be applied under § 102(e) or § 103(a), either alone or in combination with Wesinger. Accordingly, the rejections based on Cotichini are respectfully traversed.

Prior Art Citation

Applicant acknowledges the Examiner's note that the Canadian patent 2036131 has not been considered because it is not legible. Applicant notes that the copy of the Canadian patent submitted to the Examiner is the best copy Applicant has. Applicant will try to obtain a better copy and resubmit to the Examiner for consideration.

Conclusion

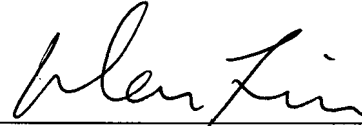
In view of all the foregoing, Applicant submits that the claims pending in this application are patentable over the references of record and are in condition for allowance. Such action at an early date is earnestly solicited. In the interest of forwarding the case to allowance without

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unnecessary delays, the Examiner is invited to call the undersigned representative to discuss any outstanding issues that may not have been adequately addressed in this response.

Respectfully submitted,

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